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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION N
10/007,393	10/26/2001	Joel S. Hochman	Athena1	9804

30996 7590 10/04/2004

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EXAMINER	
MARMOR II, CHARLES ALAN	

ART UNIT	PAPER NUMBER
3736	

DATE MAILED: 10/04/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action	Application No.	Applicant(s)	
	10/007,393	HOCHMAN ET AL.	
	Examiner	Art Unit	
	Charles A. Marmor, II	3736	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 24 August 2004 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.

b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.

2. ☒ The proposed amendment(s) will not be entered because:

   (a) ☒ they raise new issues that would require further consideration and/or search (see NOTE below);

   (b) ☐ they raise the issue of new matter (see Note below);

   (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or

   (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

   NOTE: *See Continuation Sheet*.

3. ☐ Applicant's reply has overcome the following rejection(s): _____.

4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).

5. ☒ The a)☐ affidavit, b)☐ exhibit, or c)☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: *See Continuation Sheet*.

6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.

7. ☒ For purposes of Appeal, the proposed amendment(s) a)☒ will not be entered or b)☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

   The status of the claim(s) is (or will be) as follows:

   Claim(s) allowed: _____.

   Claim(s) objected to: *1-7 and 11-15*.

   Claim(s) rejected: *8-10*.

   Claim(s) withdrawn from consideration: _____.

8. ☐ The drawing correction filed on _____ is a)☐ approved or b)☐ disapproved by the Examiner.

9. ☐ Note the attached Information Disclosure Statement(s)(PTO-1449) Paper No(s). _____.

10. ☐ Other: _____

Charles A. Marmor, II
Primary Examiner
Art Unit: 3736

Continuation of 2. NOTE: Applicant appears to have proposed an amendment to claim 14 to define the method of the present invention over the invention of the Guice patent by requiring that a human subject self-inserts the combination probe, transceiver and power source into her own vagina. While this proposed amendment appears to define the method of the present invention over the Guice patent and the other prior art of record, it raises new issues that would require additional search.
Furthermore, the Amendment After Final Rejection will not be entered because it is non-compliant for reasons set forth in the attached Notice Of Non-Compliant Amendment (37 CFR 1.121).

Continuation of 5. does NOT place the application in condition for allowance because: The request for reconsideration contends that the Guice device is an "implant" that is intended for use in livestock; and therefore, teaches away from the "non-implanted" device of the present claimed invention that is intended to be used in a human subject. Applicant provides several arguments in an attempt to support his position, including a dictionary definition of the word "implant. " This argument is not persuasive. The Examiner respectfully contends that although Guice repeatedly refers to his device as an "implant," the Guice device meets all of the structural limitations of the claimed invention of the present application. The "non-implanted" limitation can be considered as defining the intended use of the present invention. The Guice device is capable of performing this intended use as illustrated by the embodiment of Figures 18 and 19 where the Guice device is inserted into the vaginal cavity and is provided with tabs or a wire member to aid in subsequent removal of the Guice device from the vagina. Since the apparatus of the Guice patent meets all of the structural limitations of the claimed apparatus of the present invention, and is capable of being inserted intravaginally in a subject and subsequently removed, the Guice patent is considered to anticipate the present invention as claimed. Furthermore, Applicant appears to be attempting to rely on a special definition of the term "non-implanted" to define the present invention over the Guice apparatus, when no special definition of the term "non-implanted" is provided in the specification of the instant application. Applicant's arguments provide several "dictionary" definitions of the word "implant" to support his argument. However, this argument raises a possible new question of indefiniteness under 35 U.S.C. 112, second paragraph, as the Examiner has found that in the Tenth Edition of Merriam Webster's Collegiate Dictionary (1996), the verb "implant" is defined as "to insert in a living site." In view of this "dictionary" definition of the word "implant," the limitation "non-implanted" or essentially not inserted in a living site used in the claims of the present invention would appear to contradict subsequent limilations of said claims that require the device to be inserted into and contained within the vagina in order to monitor vaginal conditions.